REMARKS/ARGUMENTS

Claims 1-17 are pending in the instant application. Claims 2, 4, 7, 9 and 12 have been amended and claims 18-21 have been added to more particularly point out and distinctly claim that which Applicants consider to be their invention.

Upon entry of the above-made amendments, claims 1-21 will be pending in the current application. The amended claims 2, 4, 7, 9 and 12 and the new claims 18-21 are fully supported in the specification as originally filed. Therefore, the amendments to the claims and the new claims added do not add new matter. Applicants respectfully request that the amendments and new claims be entered.

The following remarks, in conjunction with the above amendments and new claims, are believed to be fully responsive to the Office Action.

35 USC § 112 Rejection

Claims 4, 7 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which Applicants regard as the invention.

Applicants have amended claims 4, 7 and 12 in order to comply with the requirements of 35 USC § 112, second paragraph.

Accordingly, Applicants respectfully request that the Examiner withdrawal the rejections for claims 4, 7 and 12 under 35 U.S.C. §112, second paragraph, and direct that claims 4, 7 and 12 be allowed.

35 USC § 103(a) Rejection

Claims 1-17 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,948,940 to Malthe-Sorenssen et al. ("Malthe-Sorenssen").

On page 3 of the Office Action dated November 21, 2006 ("Office Action"), the Examiner states that the difference between the present invention and Malthe-Sorenssen is that the present invention uses 1-methoxy-2-propanol as solvent, whereas the reference uses 2-methoxy-ethanol. The Examiner holds that it would be obvious to a person skilled in the art to modify the teachings of Malthe-Sorenssen by using an alternative solvent with an expectation of success.

Applicants respectfully disagree. As the Examiner is aware, there are an enormous amount of compounds having chemical structures very similar to one another that

can act very differently. This is obviously the case here. Even though the solvents in question only differ by one carbon, they act very differently.

Additionally, Applicants respectfully submit that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). (emphasis added).

Applicants and the Examiner mutually agree that Malthe-Sorenssen does not disclose, teach, or suggest even using 1-methoxy-2-propanol as a reaction solvent. Moreover, Malthe-Sorenssen does not disclose, teach, or suggest a higher purity of iohexol could be achieved by using any other type of solvent other than 2-methoxy-ethanol. One can clearly see that this actually is the case by comparing examples 1 and 2 in the present application with examples 1 and 2 in Malthe-Sorenssen.

It is well settled in case law that prior patents such as Malthe-Sorenssen are references only for what they clearly disclose or suggest. It is not proper use of a patent as a reference to modify its structure to one which prior art references do not suggest. *In re Randol and Redford*, 425 F.2d 1268, 165 U.S.P.Q. 586, 588 (C.C.P.A. 1970). A reference must be considered not just for what it expressly teaches, but also for what it fairly suggests to one who is unaware of the claimed invention. *In re Baird*, 16 F.3d 380, (Fed. Cir. 1994).

Accordingly, Applicants respectfully request that the Examiner withdrawal the rejections for claims 1-17 under 35 U.S.C. §103(a) and direct that claims 1-17 be allowed.

CONCLUSION

Upon entry of this Amendment, claims 1-17 remain pending. Applicants submit that all outstanding issues have been addressed, and that claims 1-17 are in condition for allowance, which action is earnestly solicited.

The Commissioner is hereby authorized to charge any fees under 37 CFR §1.16(j) or 37 CFR 1.136(a) which may be required, or credit any overpayment, to Deposit Account No. 502-665 in the name of GE Healthcare, Inc.

Should any other matters require attention prior to allowance of the application, it is requested that the Examiner contact the undersigned.

Respectfully submitted,

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